

REMARKS

Applicants have previously elected for prosecution on the merits the invention denoted by Group VII, wherein W is a heterocyclic moiety other than those defined in Formulae (i)-(v). The Official Action avers that this election requires a further restriction between the inventions denoted by Groups VII and VIII.

Group VII encompasses Claims 1 to 31, drawn to a method of treating pain by using the compounds having the formula (I), wherein W is defined as formula (i) wherein X₁ is oxygen or sulfur, classified in Class 514, subclass 361, 363. Group VIII, also encompassing Claims 1 to 31, is drawn to a method of treating pain by using the compounds having the formula (I), where R is a heterocyclic moiety other than those listed in Formulae (i)-(v) and (vii), classified in Class 514, subclass 183.

The Official Action avers that the inventions of Groups VII and VIII are not related to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. This, in turn, is based on the conclusion reached in the Official Action that the inventions are directed to the employment of compounds with distinct structures and lack a special technical feature. The two defined groups therefore do not represent a single inventive concept.

Applicants traverse this further restriction requirement on the ground that the method of Claims 1 to 31 are not only directed to the same inventive concept, a method for treating chronic pain, but, in addition, all 31 claims are directed to the same generic formula. The only distinction between the two allegedly separate and distinct inventions resides in the specific identity of the heterocyclic ring. That each of the heterocyclic rings within the contemplation of the present application is a five membered ring containing at least one

heterocyclic nitrogen atom establishes that the alleged distinct structural distinctiveness is very minor indeed.

The Official Action points to the classification of the two alleged separate inventions. However, the basis for the restriction requirement of record is predicated on a rule of the Patent Cooperation Treaty which does not rely on the U.S. patent classification system. Indeed, the classification system is a poor basis for requiring restriction given the continuing changes in classification to accommodate the expansion or contraction of the number of applications filed in the USPTO. That classification of inventions change over time establishes that the classification system is a poor basis for determining distinct and independent inventions.

Reconsideration and removal of the restriction requirement of record, followed by examination and passage to issue of all the claims currently in this application, Claims 1-31, is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Marvin Bressler", with a long horizontal flourish extending to the right.

Marvin Bressler
Registration No. 25,132
Attorney for Applicants

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
516-742-4343
MB:ml